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14 MAY 2007

In re Application of  
Warner  
Application No.: 10/527,046  
PCT No.: PCT/GB03/03895  
Int. Filing Date: 09 September 2003  
Priority Date: 13 September 2002  
Attorney Docket No.: 920602-98737  
For: Construction Kit

DECISION

ON

PETITION

This is a decision on applicants' renewed petition under 37 CFR 1.181 filed on 05 April 2007.

### DISCUSSION

In a Decision mailed on 05 March 2007, the petition to withdraw the holding of abandonment filed on 08 May 2006 was dismissed without prejudice because

With respect to requirement (2), petitioner states in part that "Appended hereto is a copy of the docket entries of the firm of the undersigned showing base dates (PTO action dates) of July 22, 2005. Had the Notification of Missing Requirements been received, it would have been docketed for a response deadline of September 22, 2005. As can be seen, there is no information regarding this application (file number 920602-98737) because the Notification of Missing Requirements was never received." Though this statement arguably implies that the docket records were inspected, the petition does not include an explicit statement that a search of both the file jacket and docket records indicates that the Office action was not received. Such a statement should be made by a person having first-hand knowledge of the facts involved (i.e., by the person who conducted the search). Therefore, requirement (2) has not been satisfied at this time.

Concerning requirement (3), the instant petition is accompanied by sheets which petitioner characterizes as "docket entries of the firm of the undersigned showing base dates (PTO action dates) of July 22, 2005." However, the required docket records are those records showing all applications docketed for responses due on 22 September 2005, not just applications in which the USPTO mailed correspondence on 22 July 2005 (ideally, such records would include a "tickler sheet" listing all of the application or docket numbers with responses due on 22 September 2005). The submitted docket sheets do not clearly satisfy requirement (3).

In response, petitioner now states that "a search of both the file of this office and the docket records indicates that the Office Action was not received." This statement is being accepted in satisfaction of requirement (2).

Regarding requirement (3), petitioner characterizes the docket records filed on "September 9, 2003" (taken to refer to the records accompanying the previous petition) as

docket records of the firm of the undersigned having deadlines of September 22, 2005. While a "tickler sheet" could have been generated if that "tickler sheet" were prepared prior to September 22, 2005, the docket system of the firm of the undersigned does not allow an *ex parte facto* generation of any such sheet. Thus, instead although equivalently, the records submitted to the Patent and Trademark Office contain all docket entries of the firm of the undersigned having PTO action dates (that is, mailing dates by the PTO) of July 22, 2005. Had the Notice of Missing Requirements of July 22, 2005 for this application been received, one of the records would have shown that, but as the Patent and Trademark Office can see, there is no such attachment to the Petition because no such notification was ever received from the Patent and Trademark Office. What has been provided to the Patent and Trademark Office is clearly the docket record of the firm of the undersigned where the non-received paper would have been entered had it been received.

Though counsel states that the submitted sheets are in fact "the docket record of the firm," and that the requested "tickler sheet" can no longer be generated, it is not clear how the submitted sheets were generated (and therefore, it is not clear that they should be accepted as a record of all of the cases docketed for reply on 22 September 2005). That is, was petitioner working from a list of all cases having a "Base Date" of 22 July 2005 and, if so, why has that list not been furnished? An additional concern is that, in compiling the submission, petitioner may inadvertently have overlooked other cases with the same "Base Date" or otherwise docketed for reply on 22 September 2005. For these reasons, it would not be appropriate to conclude that requirement (3) has been satisfied at this time.

### CONCLUSION

The petition to withdraw the holding of abandonment is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include be entitled "Renewed Petition Under 37 CFR 1.181."

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, and address the correspondence to the attention of the Office of PCT Legal Administration.



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